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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/817,435

04/05/2004

Erling W. Johansen

JOH-001

1290

21884 7590 10/27/2006

WELSH & FLAXMAN LLC  
2000 DUKE STREET, SUITE 100  
ALEXANDRIA, VA 22314

EXAMINER

QUINN, COLLEEN M

ART UNIT

PAPER NUMBER

3634

DATE MAILED: 10/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/817,435

Applicant(s)

JOHANSEN, ERLING W.

Examiner

Colleen M. Quinn

Art Unit

3634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date. _____   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This Office Action is in response to amendments filed August 28<sup>th</sup>, 2006, in which claims 1,3,4,10, 11, 14,15,17 and 19 were amended. Upon further review of the structural limitations of the claims, prior art was found that anticipates the claims of the applicant's claimed invention, as disclosed in the rejections below.

#### ***Drawings***

New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the drawings submitted on April 5<sup>th</sup>, 2004 are informal and are not properly presented. The figures contain varying line widths, breaks and other inconsistent informalities. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

#### ***Claim Objections***

Claims 7 and 16 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Due to the amendments made to claims 1 and 10, dependent claims 7 and 16, fail to further limit the subject matter of the previous claims as they merely reiterate subject matter already presented in the independent claims they stem from.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2 and 6- 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Drower et al. (US 5,779,066). Drower et al. disclose a holding apparatus (11) comprising one or more rectangular compartments (21, Specification, column 3, lines 55-65), made of plastic (Specification, column 2, lines 57-58), including first and second lateral sidewalls (31,32), and an open upper end (Figures 1 & 2), resilient biasing members (51), between the side walls, composed of plastic (Specification, column 3, lines 11-13), having a hollow teardrop-shape (Figure 2), with first free end (53) and second end from which a connecting leg (57) depends for attachment to the compartment (Figures 3 & 4).

Regarding claims 6 and 15, the compartments are shaped and dimensioned to sit upon a horizontal support surface (Abstract, lines 1-3).

Regarding claim 12, the biasing member is coupled to the first lateral side wall (Figure 3) and holds an article (13) in a fixed position, between the first and second side walls (Figures 1 & 2), using the resilient energy stored in the biasing member (Specification, column 1, lines 21-31).

Regarding claim 13, the teardrop-shaped biasing member's first forms the large diameter of the teardrop shape (Figure 2).

Regarding claims 14 and 19, the teardrop-shaped biasing member is secured to the first lateral side wall (via upper end slot 38), such that the free end of the member extends across toward the second lateral wall (Figure 2).

Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Hotchkiss (US 4,932,625). Hotchkiss discloses a holding apparatus (10) comprising a rectangular compartment (16), including first and second lateral sidewalls (18,22), and an open upper end (Figure 1), a resilient biasing member (50), located between and contacting both the side walls (Figure 1), composed of plastic (Specification, column 3, lines 21-24), having a hollow teardrop-shape (Figures 1, 3-5B & 7-8), with a first free end (58) forming the large diameter of the teardrop (Figure 3A), and a second end from which a connecting leg (20) depends for attachment to the compartment (Figures 1-3A). Regarding claim 5, the second end of the biasing member is secured to the first lateral side wall (Figure 3A) adjacent an upper end (26), such that the first free end of the biasing member extends across the compartment toward the opposed second lateral sidewall. Hotchkiss additionally discloses alternative structures for the resilient member (Figures 3A- 9), demonstrating design choices within the structural limitations.

### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new grounds of rejection. The examiner recognizes that the applicant incorporated particular structural limitations into the dependent claims, as discussed during the interview of August 16<sup>th</sup>, 2006; however, upon further review of the application, prior art was found that clearly anticipates the structural limitations of the amended claims, as presented in the rejections above.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. In addition to the prior art presented above, the examiner encourages the applicant to also review Drower et al. (US, 5,718,342) and Ricciardelli et al. (US 5,727,697), both of which teach key features of the applicant's claimed invention, including, but not limited to, compartments having resilient teardrop-shaped biasing members.

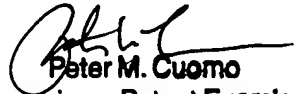
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Colleen M. Quinn whose telephone number is (571) 272-6289. The examiner can normally be reached on 8:30AM-5:00PM Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Cuomo can be reached on (571) 272-6856. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CMQ  
10/20/06

  
Peter M. Cuomo  
Supervisory Patent Examiner  
Technology Center 3600